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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LORETTA E. ALLEN, ROBERT C. BRYANT, WILLIAM H. SIMPSON, DAVID L. PATTON, and PETER A. FROSIG

Appeal 2009-001842
Application 10/762,169
Technology Center 2800

Decided: August 18, 2009

Before JOSEPH F. RUGGIERO, MARC S. HOFF, and THOMAS S. HAHN, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1 and 2, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Appeal Brief (filed October 30, 2006) and the Examiner's Answer (mailed February 22, 2007). Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived (*see* 37 C.F.R. § 41.37(c)(1)(vii)).

Appellants' Invention

The invention claimed on appeal relates to a method of providing machine-readable indicia on a media having a protective overlayer in which a first machine-readable indicia is provided on an image layer on the media. A second machine-readable indicia is provided in the protective overlayer that is identical in content to, and in register with the first machine-readable indicia. (*See generally* Spec. 17:28-18:16).

Claim 1 is illustrative of the invention and is reproduced as follows:

1. A method of providing a machine-readable indicia on a media having a protective overlayer comprising the steps of:

a) providing a first machine-readable indicia in an image layer on said media; and

b) providing a second machine-readable indicia in a protective

overlayer that is identical in content to, and in register with said first machine-readable indicia in said image layer.

The Examiner's Rejection

The Examiner relies on the following prior art reference to show unpatentability:

Soscia	US 6,636,332 B1	Oct. 21, 2003 (filed Feb. 5, 1998)

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Soscia.

ISSUE

The pivotal issue before us in making the determination as to whether the Examiner erred in rejecting appealed claims 1 and 2 under 35 U.S.C. § 102(e) is whether Appellants have demonstrated that the Examiner erred in determining that Soscia discloses a media with a machine readable indicia in a protective layer that is identical in content *and in register* with a machine-readable indicia in an image layer of the media.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants disclose an embodiment in which identical indicia is printed on an image layer 26 and a protective overlayer 14 of media 18. The information bearing indicia 34 in the protective overlayer 14 and the image

32 in the image layer 26 of media 18 have the same information and the "location of the information bearing indicia 34 exactly overlap the image 32 on print 18." (Fig. 9, Spec. 17:29-18:8).

2. Appellants also disclose (Spec. 18:9-16) in the figure 9 embodiment that the reflective characteristics of the protective layer 14 is altered in the area of the information bearing indicia 34 that is in register with image 32 so as to enhance the readability of the indicia on label 30.

3. Soscia discloses (figs. 3 and 4) a recording medium on which is printed an image 20 and indicia 40 which is a digital representation of the image 20, with the indicia being incorporated within layer 100.

4. Soscia also discloses (col. 3, ll. 34-38) that indicia 40 can be printed on any desired portion of the image 20 and may be appended to the image 20.

5. Soscia further indicates (col. 4, ll. 20-23) that the indicia 40 is preferably overlaid on image 20 which in turn is printed on recording medium 50.

PRINCIPLES OF LAW

It is well settled that in order for the Examiner to establish a prima facie case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. *See generally In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984). "'Inherency, however, may not be

established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.'" *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) (quoting *Hansgirg v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939). The reference must teach each and every claim limitation, it must be enabling, and it must describe the claimed subject matter sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 1346 (Fed. Cir. 2000); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

During examination of a patent application, a claim is given its broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). "[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.,* 415 F.3d 1303, 1312 (Fed. Cir. 2005).

ANALYSIS

Appellants' arguments in response to the Examiner's anticipation rejection, based on Soscia, of appealed claims 1 and 2 assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Soscia so as to establish a prima facie case of anticipation. At page 4 of the Brief, Appellants' arguments focus on the contention that, in contrast to the requirements of claims 1 and 2, Soscia has no disclosure of a machine readable indicia in a protective layer that is identical in content *and in register* with a machine-readable indicia in an image layer of a media.

We agree with Appellants. In addressing the language of claims 1 and 2, the Examiner directs attention (Ans. 3-4) to the portions of the disclosure of Soscia (col. 3, ll. 34-51 and col. 4, ll. 20-22) which describe the indicia 40 as being variously printed, overlaid on, or appended to image 20. We find nowhere, however, in the stated position where the Examiner explains how Soscia's various disclosed suggested ways of applying indicia 40 to image 20 would result in indicia 40 being "in register" with image 20.

Since Appellants have provided no explicit definition of the term "register" in the Specification, we look to the ordinary and customary meaning of the term in the context of the claimed invention, which is "to correspond exactly."[1] *See Phillips,* 415 F.3d at 1312. This definition of "register" comports with what is illustrated in figure 9 of Appellants' drawing and what is described at page 18, lines 9-16 of Appellants' Specification. As described and illustrated, the image 34 in Appellant's protective layer 14 exactly overlaps the image 32 on print 18 with the reflective characteristics of the protective layer 14 being altered in the area of the information bearing indicia 34 that is in register with image 32 so as to enhance the readability of the indicia on label 30 (FF 1, 2).

With the above discussion in mind, it is apparent to us that an ordinarily skilled artisan, when reading the disclosure of Soscia, would not consider the indicia 40 in layer 100 to be "in register" with the image 20 as presently claimed. In view of the above, since all of the claim limitations

[1] Webster's Ninth New Collegiate Dictionary (Houghton Mifflin Company 1990), p. 992. ((This dictionary definition was supplied by Appellants (App. Br. 4), which definition is not disputed by the Examiner.))

are not present in the disclosure of Soscia, we do not sustain the Examiner's 35 U.S.C. § 102(e) rejection of appealed claims 1 and 2.

CONCLUSION

Based on the findings of facts and analysis above, we conclude that Appellants have shown that the Examiner erred in rejecting claims 1 and 2 for anticipation under 35 U.S.C. § 102(e).

DECISION

The Examiner's decision rejecting claims 1 and 2 under 35 U.S.C. § 102(e) is reversed.

REVERSED

gvw

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